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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10027	7590	11/01/2005	EXAMINER	
ANDERSON, LEVINE & LINTEL L.L.P.			LEMMA, SAMSON B	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,049

Applicant(s)

CHANG ET AL.

Examiner

Samson B. Lemma

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2,4 & 5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Claims 1-37** have been examined.

Specification

2. The disclosure is objected because of the following informalities:

- On Abstract, the last 4 lines, the following has been recited, "In one embodiment, the information is stored in the memory, and **the** obtaining the information that is stored in the memory by processing the information..." The word "the" before the word "obtaining" should be cancelled.
 - On page 1, line 25 and , "a system bus 104" referring to figure 1 has been recited. However the corresponding figure 1, does not indicate the reference.
 - On page 19, line 19-21, "a system bus 104" referring to figure 1, has been recited. However, the corresponding figure 1, does not indicate the reference.
- Appropriate correction is required.

Drawings

- As indicated above the disclosure contains recitations referring to Figure 1, in particular to "a system bus 104", the corresponding figure 1 should have included the reference "104".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 6,17-18,25-26,29-30** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claims 6,17-18,25-26,29-30** recites the term "substantially". It is a relative term and does not have a clear and well defined meaning. It has not been considered in the examination procedure. It has to be defined explicitly.

5. **Claims 19, 27-28 and 31** depend from the rejected claims 17 and 25 respectively, and include all the limitations of the respective claims, thereby rendering those dependent claims indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

7. **Claims 1-24** are rejected under 35 U.S.C. 102(e) as being anticipated by **Jeong et al.**

(hereinafter referred as **Jeong**) (U.S. Publication No 2002/0174351 A1)

8. **As per claim 1** Jeong discloses a method for accessing a memory storage device, [paragraph 0034;figure 1, ref. Num "400"] (As explained on paragraph "0034", when the user access information stored in the hard disk shown on figure 1, ref. Num "400") [**the memory storage device** (figure 1, ref. Num "400") **being in communication with a host system** [figure 1, ref. Num "300"] **through an adapter**,[figure 1, ref. Num "100"] **the memory storage device including a memory**,[figure 1, ref. Num "400"] **the method comprising:**

- **Obtaining a key from the adapter**, [Paragraph 0014] (As explained on paragraph 0014, the adapter includes a first bus interface, a second bus interface and a ROM BIOS shown on figure 1, ref. Num "200" and as also indicated on paragraph 0014, the ROM BIOS stores the keys] **the key being arranged to encrypt information that is arranged to be stored in the memory, the key further being arranged to decrypt the encrypted information, wherein the key is stored on the adapter; and processing the information using the key.** [Paragraph 0034 and paragraph 0035] (As indicated on paragraph 0034 and 0035, using the keys or after obtaining the keys which are stored in the ROM BIOS which is part of the adapter the information is both encrypted/decrypted.)

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9. **As per claim 13 Jeong discloses a system comprising: a memory storage device**
the memory storage device including a memory [figure 1, ref. Num 400]; and

- **An adapter, the adapter being arranged to interface with the memory storage device, [figure 1, ref. Num "100"] (the adapter shown on figure 1, ref. Num "100" is interfaced to the memory storage device as shown on figure 1, ref. Num "400" through the IDE bus as shown on figure 1, ref. Num "20") wherein the adapter is arranged to store a key that is associated with the memory storage device. [Paragraph 0014;paragraph 0034 & 0035] (As explained on paragraph 0014, the adapter includes a first bus interface, a second bus interface and a ROM BIOS shown on figure 1, ref. Num "200" and as also indicated on paragraph 0014, the ROM BIOS stores the keys that is associated with the memory device as indicated on paragraph 0034 and paragraph 0035. Using the keys which are stored in the ROM BIOS which is part of the adapter the information from/to the hard disk shown on figure 1, ref. Num "400" is either encrypted/decrypted as necessary. The keys are associated to the memory device since the these keys are used to encrypt information which is to be stored in the hard disk and also to decrypt information stored in the hard disk as the user is requesting information from the hard disk.)**

10. **As per claims 2-3 and 21 Jeong discloses a method/system as applied to claims above. Furthermore Jeong discloses the method/system wherein, the information is stored in the memory, and the method further includes: obtaining the information that is stored in the memory, wherein processing the information using the key includes decrypting the information using the key. [Paragraph 0014;paragraph 0034 & 0035]**

11. **As per claims 4 and 20 Jeong discloses a method/system as applied to claims above. Furthermore Jones discloses the method/system, further including: storing the**

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encrypted information in the memory. [paragraph 0035] (As explained on paragraph 0035, the enciphered information is stored in the hard disk memory shown on figure 1, ref. Num 400)

12. **As per claims 5-9 and 16-19 Jeong discloses a method/system as applied to claims above. Furthermore Jeong discloses the method/system, wherein obtaining the key from the adapter includes: providing a first password to the adapter; determining when the first password is valid; and decoding contents associated with the adapter using the first password when it is determined that the first password is valid, wherein the contents include the key. [Paragraph 0038-0052 ; paragraph 0014; paragraph 0034 & 0035]**

13. **As per claims 10-11 and 22-23 Jeong discloses a method/system as applied to claims above. Furthermore Jeong discloses the method/system, wherein the memory storage device is a memory card that includes a non-volatile memory. [figure 1, ref. Num "400"]** (hard disk shown on figure 1, ref. Num "400" is a non-volatile memory and meets the recitation of the limitation of the storage device since A hard disk, which stores the user's files and programs keeps data even if the computer is turned off)

14. **As per claims 12 and 24 Jeong discloses a method/system as applied to claims above. Furthermore Jeong discloses the method/system, wherein the adapter is one of a Universal Serial Bus (USB) reader and a Personal Computer Memory Card International Association (PCMCIA) adapter. [Figure 1, ref. Num "100"]**

15. **As per claims 14 Jeong discloses a method/system as applied to claims above. Furthermore Jeong discloses the method/system, wherein the host, the host being in communication with the adapter such that the host may communicate with the memory storage device through the adapter. [Paragraph 0034 and figure 1]**

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16. **As per claims 15 Jeong discloses a method/system as applied to claims above.**

Furthermore Jeong discloses the method/system, wherein the host includes: means for accessing the key. [Paragraph 0014]

17. **Claims 25-37** are rejected under 35 U.S.C. 102(b) as being anticipated by Santon et al. (hereinafter referred as **Santon**) (U.S. Patent No 5,058,162)

18. **As per claim 25 Santon discloses a reader comprising :** [Abstract] (providing a recipients with media reading device)

- **A receptacle, the receptacle being arranged to receive a memory card; an interface, the interface being arranged to enable the reader to communicate with a host; and [column 7, lines 20-26; column 3, lines 11-19; and column 2, lines 56-57 and column 5, lines 9-13 & lines 25-26 and figure 1][Reader/reading device as disclosed on column 3, lines 11-19 and column 2, lines 56-57, inherently includes a receptacle which enables memory medium/media shown on figure 1, ref. Num "10" and figure 2, which are distributed to the users as indicated on column 1, lines 11-14 and column 5, lines 9-13 to communicably interface with reader such that reader shown on figure 1, ref. Num "100" as explained on column 5, lines 25-26 enable communications to be made between memory media shown on figure 1, ref. Num "10" and a host computer shown on figure 1, ref. Num "200"]. This feature is also described on column 7, lines 20-22]**

- **The area being arranged to store contents, wherein the contents are password-protected. [Column 2, lines 38-51; column 8, lines 52-64 and figure 7b]**

19. **As per claim 26 Santon discloses a reader as applied to claim above. Furthermore, Santon discloses the reader wherein the contents include a key, the key being arranged**

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to enable information to be written to or s read from the memory card. [Column 3, lines 14-15]

20. **As per claim 27 Santon discloses a reader as applied to claim above. Furthermore, Santon discloses the reader further including: a password processing arrangement, the password processing arrangement being arranged to receive a password through the interface, wherein the contents are arranged to be retrieved from the area through the interface by the host when the received password is appropriate. [Column 2, lines 38-51; column 2, lines 62-column 3, lines 3]**

21. **As per claim 28 Santon discloses a reader as applied to claim above. Furthermore, Santon discloses the reader wherein the password processing arrangement is arranged to determine whether the received password is appropriate. [Column 2, lines 64]**

22. **As per claim 29-31 Santon discloses a reader as applied to claim above. Furthermore, Santon discloses the reader wherein the password processing arrangement is arranged to decode the contents when it is determined that the received password is appropriate before the contents are retrieved through the interface by the host. [Column 2, lines 62-column 3, lines 3]**

23. **As per claim 32-37 Santon discloses a method for accessing protected contents on a reader, the reader being in communication with a host, wherein the reader is arranged to receive a memory card, [Column 3, lines 4-19, column 7, lines 20-26; column 3, lines 11-19; and column 2, lines 56-57 and column 5, lines 9-13 & lines 25-26 and figure 1][Protected contents which are stored being encrypted on the medium is being accessed on a reader device as explained on column 3, lines 4-19 and the Reader/reading device as disclosed on column 3, lines 11-19 and column 2, lines 56-57, inherently includes a receptacle which enables memory medium/media shown on figure 1, ref. Num "10" and figure 2, which are distributed to the users as indicated on column 1, lines 11-14 and column 5, lines 9-13 to communicably**

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interface with reader such that reader shown on figure 1, ref. Num "100" as explained on column 5, lines 25-26 enable communications to be made between memory media shown on figure 1, ref. Num "10" and a host computer shown on figure 1, ref. Num "200". This feature is also described on column 7, lines 20-22], **the method comprising:**

- **Determining when functionality associated with supporting the protected contents is enabled on the reader;** [Column 2, lines 38-51 and column 2, lines 62-68] (As explained on the dependent claim 37 determining when the functionality associated with supporting the protected contents is enabled includes: providing a password to the reader and this is disclosed on column 2, lines 38-51 and also column 2, lines 62-68] and
- **Accessing a section of the reader that is arranged to store protected contents when it is determined that the functionality associated with supporting the protected contents is enabled.** [column 3, lines 1-3 and column 3, lines 6-19 and column 2, lines 62-column 3, line 19] (As explained on dependent claims 33-36, accessing a section of the reader that is arranged to store protected contents includes: encrypting a data stream; providing the encrypted data stream to the reader; and writing the encrypted data stream into the section. reading data from the section of the reader and decrypting the data read from the section of the reader and all of these are disclosed on column 3, lines 4-19 and column 2, lines 62-column 3, lines 19]

24. **Claims 1-37** are also rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al. (hereinafter referred as **Jones**) (U.S. Patent No 5,623,637)

25. **As per claim 1-12 Jones discloses a method for accessing a memory storage device,** [column 2, lines 3-4] (It is a further object of the present invention to provide a secure data storage device which may, at the option of the user, selectively limit access to all or part of the stored data using one or more passwords) **the memory storage device** [figure 2, ref. Num "150"] **being in communication with a host system** [figure

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2, ref. Num "110"] **through an adapter,**[figure 2, ref. Num "250"] **the memory storage device including a memory,**[figure 2, ref. Num "150"] **the method comprising:**

- **Obtaining a key from the adapter, the key being arranged to encrypt information that is arranged to be stored in the memory, the key further being arranged to decrypt the encrypted information, wherein the key is stored on the adapter; and processing the information using the key.** [Abstract; column 6, lines 5-16] (As explained on the abstract and column 6, lines 5-16., the key value is stored on the smartcard/adapter and obtained/fetched form the EPROM "257" and the key is used to encrypt/decrypt information that is to be stored in the memory shown on figure 2, ref. Num "150"]

26. **As per claim 13-37 Jones discloses a system comprising: a memory storage device** the memory storage device including a memory **[figure 2, ref. Num "150"]**; and

- **An adapter, the adapter being arranged to interface with the memory storage device, [figure 2, ref. Num "250"] wherein the adapter is arranged to store a key that is associated with the memory storage device.** [Abstract; column 6, lines 5-16] (As explained on the abstract and column 6, lines 5-16., the key value is stored on the smartcard/adapter and obtained/fetched form the EPROM "257" and the key is used to encrypt/decrypt information that is to be stored in the memory shown on figure 2, ref. Num "150"]

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.(See PTO-Form 892).

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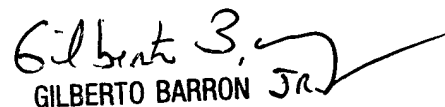
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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